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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/807,560 | 03/23/2004 | David L. Marvit | 073338.0195 (04-50467 FLA | 4252 |
| 5073 | 7590 | 07/20/2007 | EXAMINER | |
| BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980 | | | LIANG, REGINA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2629 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 07/20/2007 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mike.furr@bakerbotts.com
ptomail1@bakerbotts.com

Office Action Summary

Application No.

10/807,560

Applicant(s)

MARVIT ET AL.

Examiner

Regina Liang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-10,12-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-10,12-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The finality of last action is withdrawn.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3, 5-10, 12-17, 19-21 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 7,180,500. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious over each other.

The following is an example for comparing claim 1 of this application and claim 7 of U.S. Patent No. 7,180,500.

| | |
|-------------------------------------|-------------------------------------|
| Claim 1 of this application | Claim 7 U.S. Patent No. 7,180,500 |
| A motion controlled handheld device | A motion controlled handheld device |

| | |
|--|---|
| comprising: a display having a viewable surface and operable to generate an image; | comprising: a display having a viewable surface and operable to generate an image; and |
| a gesture database maintaining a plurality of predefined gestures, each gesture defined by a motion of the device with respect to a first position of the device; | a gesture database maintaining a plurality of gestures, each gesture defined by a motion of the device with respect to a first position of the device; |
| an application having a plurality of predefined commands; | an application having a plurality of predefined commands; |
| a motion detection module operable to detect motion of the handheld device within three dimensions and to identify components of the motion in relation to the viewable surface; | a motion detection module operable to detect motion of the handheld device within three dimensions and to identify components of the motion in relation to the viewable surface; |
| a gesture mapping database comprising a command map for the application, the command map comprising mappings of the selected gestures to the corresponding commands as indicated by the user input; | a gesture mapping database comprising a command map for the application, the command map comprising a mapping of the new gesture to the associated command as indicated by the user input; |
| and a control module operable to load the application, to track movement of the handheld device using the motion detection module, to compare the tracked movement against the | and wherein the control module is further operable to: load the application; track movement of the handheld device using the motion detection module; match the tracked |

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| gestures to determine a matching one of the gestures, to identify, using the command map, the command mapped to the matching gesture, and to perform the identified command using the application; | movement against the new gesture; identify, using the command map, the associated command mapped to the new gesture; and perform the associated identified command using the application. |
| wherein the control module is further operable to: detect an indication to record a new gesture; detect a stabilization of the components of the motion of the device; upon detecting the stabilization, determine a base reference position; record movement of the device with respect to the base reference position; detect an indication to stop recording the new gesture; define the new gesture using the recorded movement of the device with respect to the base reference position; and store the new gesture in the gesture database; | a control module operable to: detect an indication to record a new gesture; detect a stabilization of the components of the motion of the device; upon detecting the stabilization, determine a base reference position; record movement of the device with respect to the base reference position; detect an indication to stop recording the new gesture; define the new gesture using the recorded movement of the device with respect to the base reference position; and store the new gesture in the gesture database; |
| a user interface operable to receive user input associating selected ones of the gestures with corresponding ones of the command sand wherein the user interface is further operable to receive user input associating the new gesture | a user interface operable to receive user input associating the new gesture with one of the commands; |

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| with at least one of the commands. | |
|------------------------------------|--|

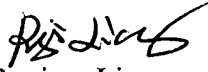
As can be seen above, claim 1 of this application is similar to claim 7 of U.S. Patent No. 7,180,500.

In view of the above analysis, applicant's claim 1 and patent claim 7 are not patentably distinct from one another and in absence of a terminal disclaimer would result in an unjustifiable time wise extension of applicant patent.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina Liang whose telephone number is (571) 272-7693. The examiner can normally be reached on Monday-Friday from 8AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (571) 272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Regina Liang
Primary Examiner
Art Unit 2674

7/12/07